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July 31, 2008

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The Honorable Gregory M. Sleet
United States District Court
844 King Street
Wilmington, Delaware 19801

REDACTED
PUBLIC VERSION

Re: Cisco v. Telcordia, C.A. No. 07-113-GMS

Dear Chief Judge Sleet:

Cisco's answering summary judgment letter regarding non-infringement purports to create factual disputes. Cisco's alleged "disputes," however, do not address the actual material facts underpinning Telcordia's motion. Indeed, when Cisco's misdirection is stripped away, it is clear that many of Telcordia's grounds for summary judgment remain undisputed. As such, summary judgment of non-infringement is proper.

Telcordia Cannot Be Liable for Direct Infringement by "Making" or "Selling" or "Offering to Sell"

Cisco does not dispute that Telcordia does not "make," "sell," or "offer to sell" the claimed methods. Therefore, as a matter of law, Telcordia is entitled to at least partial summary judgment of no direct infringement for the acts of "making," "selling, and "offering to sell" the accused products. This is an important issue, because it will limit the issues for trial and reduce the burden for the Court and jury.

With respect to Cisco's allegation of direct infringement via the "use" provision of 35 U.S.C. § 271, Cisco alleges infringement only when Telcordia tests the accused software in its own labs. However, Cisco's argument that Telcordia "uses" the patented methods is based entirely on mischaracterized and misleading witness testimony. Of course Telcordia tests its software, but the claimed methods require more than just functional steps. They also require certain network configurations and communication messages. There simply is no evidence that Telcordia has ever tested those required features. Cisco inaccurately recounts Peter Farley's testimony when it states that Mr. Farley "confirmed that Telcordia has tested in its own lab in New Jersey every feature of the accused systems." (Cisco Answering Letter, at 1). In fact, when asked about specific features, Mr. Farley states quite clearly that he does not test certain accused features because they are not a requirement of the product and are not supported by the product. Ex. A [Farley Dep. Tr.] at 47:22-48:14, and 56:2-57:22.

Telcordia Cannot Be Liable for Indirect Infringement of the Asserted Method Claims

Cisco suggests that it will rely on circumstantial evidence to prove direct infringement by the customers. Cisco is entitled to rely on circumstantial evidence, but the question remains

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“what does the circumstantial evidence show?” In this case, the evidence that Cisco points to shows that Telcordia’s customers could install the accused software and use some of its features. That does not mean that every customer uses every feature of that software. Moreover, Cisco’s infringement contentions point to additional features that are allegedly developed by customers and are separate from the accused Telcordia software products. And, there is no evidence that customers develop and use such additional features in conjunction with each and every feature of the accused software. None of the circumstantial evidence that Cisco points to fills in these missing blanks.

Importantly, there are many alternative features, configurations, and messages for the accused software that are not even accused of infringing. In these circumstances, “hypothetical instances of direct infringement are insufficient to establish vicarious liability or indirect infringement.” *ACCO Brands, Inc. v. ABA Locks Mfrs. Co.*, 501 F.3d 1307, 1313 (Fed. Cir. 2007) (further stating that plaintiff “must prove specific instances of direct infringement or that the accused device necessarily infringes the patent....[T]he mere sale of a product capable of substantial non-infringing uses does not constitute indirect infringement of a patent.”) Without evidence of a specific instance of direct infringement, Telcordia cannot be liable for the alleged indirect infringement.

Cisco strings together line after line of unsupported statements and speculates as to how a single customer may allegedly use the accused products. Despite having concluded fact discovery and submitting over 650 pages of exhibits with its answering letter, Cisco cites nothing in the record to support its arguments. There simply is no evidence of a single customer using each and every step of the claimed methods, nor can there be.

Contrary to what Cisco represents, the claims are in fact directed to different parties to perform different acts. Indeed, Cisco cannot dispute that the asserted method claims require certain network processes to be performed by independent network elements through the execution of separate software. The network elements, including the functions they perform and the software they execute, operate separately, independently, and outside the control of any one user of the accused products. The Federal Circuit’s just-announced decision in *Muniauction, Inc. v. Thomson Corp.*, No. 2007-1485, 2008 WL 2717689 (Fed. Cir. July 14, 2008) holds that direct infringement liability cannot be predicated on such an aggregation of activities. For Cisco to suggest otherwise, it must at least show evidence of a single customer that (1) uses the accused Telcordia products to communicate with network elements, (2) owns, operates and controls the very same network elements it communicates with, and (3) executes software on those network elements. This, Cisco has failed to do.

Telcordia Does Not Infringe Claim 7 of the ‘622 Patent

Cisco suggests that summary judgment based on the claim term socket “seems to warrant further consideration,” but essentially falls back on the doctrine of equivalents. (Cisco Answering Letter, at 4). Cisco does not contest the facts that: (1) the accused NMA and OCS software operate on a VOS platform, not UNIX; and (2) that the accused Elcom software operates with an API that was developed for HP-UX, not “the Berkeley version of AT&T’s UNIX operating system” as required by the Court’s claim construction. Given these deficiencies

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in Cisco's case, there can be no dispute that Telcordia does not literally infringe. As such, Telcordia is at least entitled to partial summary judgment of no literal infringement of claim 7.

Cisco is not entitled to any scope of equivalents with respect to the claim term "socket," because to do so would completely vitiate the express limitations of the Court's construction. *Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005) ("[A]n element of an accused product or process is not, as a matter of law, equivalent to a limitation of the claimed invention if such a finding would entirely vitiate the limitation.").

Moreover, there can be no equivalents because prosecution history estoppel bars the application of that doctrine for the same reasons that the prosecution history helped construe the term "socket." The Court already concluded as much. Based on its review of the prosecution history, the Court found that "the patentee clearly inform[ed] the patent examiner that work [sic] socket 'has a *precise meaning* set forth in Applicant's Specification, page 3, line 26, through page 4, line 1-9.'" (D.I. 46, at 2 n.1) (original emphasis). "The prosecution disclaimer standard is the same standard applicable, in the context of doctrine of equivalents, to the doctrine of argument-based estoppel." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1363 (Fed. Cir. 2003). Thus, Cisco is estopped from asserting the doctrine of equivalents.

Telcordia Does Not Infringe Claim 1 of the '988 Patent

As to the requirements of Claim 1, Cisco does not dispute that a "generic instruction" must be applicable to more than one network element. As to the operation of the Accused Products, Cisco also does not contest the fact that the products require each and every instruction generated to specify the individual network element where the command will be sent and the channel connected to that network element that will carry the instruction. Nor does Cisco dispute the fact that any such instruction generated is not applicable to more than one element, in direct contrast to what the claim requires. On these grounds alone, summary judgment of non-infringement is proper.

Cisco argues—for the first time—that the alleged "generic instruction" is a command for invoking a macro, and that sending device-specific commands one at a time is exactly what the '988 Patent requires. As its very name suggests, however, a command for a macro is a command that is only applicable to a single macro, not "groups of elements," as required by the claims. Likewise, Cisco's contention that the '988 Patent claims the concept of translating a generic command into device-specific commands sent one at a time to each network element contradicts the prosecution history, where the patentee expressly distinguished the prior art on the grounds that it, too, converted a generic command to device-specific commands sent one at a time to each network element. Ex. B. [Request for Reconsideration, July 18, 2001], at TCORDEL 0000558 (distinguishing the prior art from the claims on the grounds that the prior art discloses each individual network element having its own individual instruction generated from a generic instruction). As such, Cisco's arguments are untenable.

Respectfully,

/s/ Steven J. Balick

Steven J. Balick

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SJB/rbg

Attachments

- c: Vincent P. Kovalick, Esquire (via electronic mail; w/attachments)
- Jack B. Blumenfeld, Esquire (by hand, and via electronic mail; w/attachments)
- Matthew D. Powers, Esquire (via electronic mail; w/attachments)

EXHIBIT A

REDACTED

EXHIBIT B

709	224	Class	Subclass
709		224	
ISSUE CLASSIFICATION			
SCANNED 6			

6377988

UTILITY SERIAL NUMBER	08/836301	PATENT DATE	APR 23 2002	PATENT NUMBER	6377988
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SERIAL NUMBER	08/836301	FILING DATE	08/11/97	CLASS	395	SUBCLASS	230	GROUP ART UNIT	275	EXAMINER	ROBERTO
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APPLICANTS ADAM SHOOTER LONDON, GREAT BRITAIN; PAUL ABRAHAM, CROYDON, GREAT BRITAIN;

CONTINUING DATA***

VERIFIED THIS APPLN IS A 371 OF PCT/GB95/02617 11/07/95 ✓

Yes! al

FOREIGN/PCT APPLICATIONS***

VERIFIED GREAT BRITAIN 9422722.0

11/10/94 ✓

Yes! al

Foreign priority claimed 35 USC 119 conditions met	<input checked="" type="checkbox"/> yes <input type="checkbox"/> no	AS FILED	STATE OR COUNTRY	SHEETS DRWGS.	TOTAL CLAIMS	INDEP. CLAIMS	FILING FEE RECEIVED	ATTORNEY'S DOCKET NO.
Verified and Acknowledged	Examiner's Initials	→	GB3	5	25	4	\$1,230.00	A24800 US

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TITLE
CONTROLLING ELEMENTS OF A TELECOMMUNICATIONS NETWORK

U.S. DEPT. OF COMM./PAT. & TM—PTO-438L (Rev.12-84)

3/14/02 Filed 03/14/02 (5 sheets) set 1		6/11/97	
PARTS OF APPLICATION FILED SEPARATELY		Applications Examiner	
NOTICE OF ALLOWANCE MAILED		CLAIMS ALLOWED	
12.03.01		Total Claims	Print Claim
MARK D. THOMPSON Assistant Examiner		23	1
ISSUE FEE		DRAWING	
Amount Due	Date Paid	Sheets Drwg.	Figs. Drwg.
	2-28-02	5	8
MARK H. NINEHART SUPERVISORY PATENT EXAMINER TECHNICAL CENTER 210A		Print Fig.	2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SPECTOR et al

Serial No. 08/836,301

Filed: May 11, 1997

For: CONTROLLING ELEMENTS OF A
TELECOMMUNICATIONS NETWORK

Atty. Ref.: 36-1023

Group: 2152

Examiner: A. Romero

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Technology Center 2100

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JUL 20 2001
Technology Center 2100

* * * * *

July 18, 2001

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

In response to the Office Action dated April 24, 2001, applicants respectfully request reconsideration of the above-identified patent application in view of the remarks set forth below.

REMARKS

Claims 1, 3-14 and 16-25 are presently pending in the instant application. Applicants appreciate the Examiner's indication that the final rejection is overcome.

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Gray is directed to a method of automatically managing a network or remote function-executing apparatus from a programmable network control center. According to Gray, a master function memory stores a master function listing of all possible functions to be executed by the apparatus at each site. In managing the network of apparatus, a user composes a listing of plural sites selected from the master site listing and a listing of functions for each site from the master function listing, which are stored in a correlated listing memory section. After the correlated listing has been stored, upon a single execution signal set by the user, commands representing the selected functions are transmitted over communications links to the selected sites, without further participation by the user, and the apparatus at the selected sites executes the functions upon receipt of the commands.

As the Examiner has correctly noted, there is no teaching or suggestion in Gray of converting a generic instruction to group-specific instructions appropriate to each group of elements in which there is at least one of the selected elements. Furthermore, there is no teaching or suggestion in Gray of transmitting to each selected element the group-specific instruction appropriate to its group.

These two important aspects of the claimed invention clearly distinguish the claimed invention over the cited references. First, there is a requirement that the group-specific

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time by avoiding the need to generate instructions for groups that have no selected members. It is noted that in different control scenarios, the same group may not be "empty" because different elements will be selected according to the situation being controlled. Second, for each group of elements only one group-specific instruction is generated. Thus, if there are several elements which each require identical instructions, processing time is saved by only generating a single instruction for all elements.

Smith fails to overcome the fundamental deficiencies of Gray noted above. In particular, Smith discloses a method and apparatus for providing arbitrary definition of groups in a data communications network management system. Groups are added, modified, merged, deleted or displayed as desired by the user so that all members of the arbitrarily defined group can be addressed as a group, for example to do a self test and report results of the test. Collectives can be defined as members of the group and the collectives can be unpacked at the time of issuance of a command rather than at the time of creation of the group so that changes to the collective are reflected as changes to the group automatically. Smith also discloses creation of groups which are commonly desired and significant group configuration activity is logged to either a printer or a file.

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there is at least one of the selected elements, and of transmitting to each selected element the group-specific instruction appropriate to its group.

As discussed above, the claims specifically require that the group-specific instructions are converted from the generic instruction if at least one of the previously selected elements requires that group-specific instruction ("converting the generic instruction to group-specific instructions appropriate to each group of elements *in which there is at least one of the elements*" emphasis added). Thus, if there is not at least one selected element in a given group, there is no need to generate a group-specific instruction for that "empty" group. This provides the previously unrecognized advantage of reducing the processing time by avoiding the need to generate instructions for groups that have no selected members. There is simply no teaching or suggestion of this feature in Smith.

Additionally, contrary to the allegations contained in the Office Action, there is no teaching or suggestion in Smith of "converting" as set forth in the claimed invention. Quite to the contrary, Smith requires, at Col. 9, lines 41-45, that the group oriented command is converted to individual commands directed towards each individual member of the group. There is no determination of the propriety of sending the command. At the level discussed in Smith, the

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beyond this rudimentary method by avoiding any unnecessary duplication in that step by only generating one command for all members of a group that can use identical commands

Similarly, Gray requires predetermined functions to be carried out in each of a number of selected site controllers in response to a single command from the operator. In complete contrast, according to the claimed invention, it is necessary for there to be a plurality of elements in at least one selected group. The claimed invention does not indiscriminately send commands to groups.

Moreover, both Gray and Smith teach that individual instructions be transmitted to each of the elements to be commanded by the initial operator instruction. There is no group of more than a single member for which all members, receive a group-specific instruction, because in both Gray and Smith, each element will have its own individual instruction generated, even if those instructions would be identical. This solution is entirely at odds with the claimed invention, where one command is generated for all members of a group that can use identical commands.

As set forth above, it is respectfully submitted that Smith fails to overcome the fundamental deficiencies noted with respect to Gray. Therefore, it is respectfully submitted that even if, *arguendo*, the combination of Gray and Smith were proper, the combination nevertheless

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fails to render the claimed invention obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

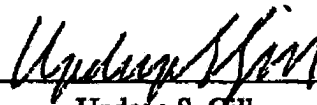
In view of the foregoing, it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited.

Should the Examiner deem that further issues require resolution prior to allowance, the Examiner is invited to contact the undersigned attorney of record at the telephone number set forth below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 36-1023

SPECTOR et al

C# M#

Serial No. 08/836,301

Group Art Unit: 2152

Filed: May 11, 1997

Examiner: A. Romero

Date: July 18, 2001

Title: CONTROLLING ELEMENTS OF A TELECOMMUNICATIONS NETWORK

Assistant Commissioner for Patents
Washington, DC 20231

2152

RECEIVED
JUL 20 2001
Technology Center 2100

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment	23	minus highest number		
previously paid for	23	(at least 20) =	0 x \$ 18.00	\$ 0.00
Independent claims after amendment	2	minus highest number		
previously paid for	3	(at least 3) =	0 x \$ 80.00	\$ 0.00
If proper multiple dependent claims now added for first time, add \$270.00 (ignore improper)				\$ 0.00
Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$390.00/2 months; \$890.00/3 months)				\$ 0.00
Terminal disclaimer enclosed, add \$ 110.00				\$ 0.00
<input type="checkbox"/> First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$710.00)				\$ 0.00
<input type="checkbox"/> Please enter the previously unentered, filed				
<input type="checkbox"/> Submission attached				

Subtotal \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract

-\$ 0.00

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00)

\$ 0.00

Assignment Recording Fee (\$40.00)

\$ 0.00

Other:

0.00

TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.